

REMARKS

In the present Office Action, claims 22-31 have been considered. Original claims 1-21 have been deleted, and claims 29-31 were added by preliminary amendment. In the present amendment, each of claims 22-31 has been amended and new claims 32-37 have been added. After entry of the amendment, claims 22-37 remain for consideration.

Claims 22-31 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-21 of US. Patent No. 6,622,038. Applicants acknowledge the provisional rejection. However, because no claim has been indicated as allowable, a terminal disclaimer is premature at present. Applicants will timely file a terminal disclaimer upon indication of allowable claims properly rejected on this basis.

Claims 22-31 further stand rejected as anticipated under 35 U.S.C. §102(b) by US 5,025,807 to Zabara. According to the Examiner:

Col. 7, lines 7+ teach electrode placement along any part of the vagus nerve. The specific location of the electrodes in applicant's claims is considered to be intended use, not a structural limitation.

Office Action of 11/25/05, at 3 lines 9-11.

While the '807 patent does note that it is "theoretically possible" to couple an electrode "anywhere along the length of the vagus nerve" ('807 patent at col. 7 lines 7-9), the only location actually disclosed in the '807 patent for electrode placement on the vagus nerve is at the cervical (i.e., neck) area. Moreover, the specific comment referred to by the Examiner at col. 7 lines 7-11 merely teaches that the electrodes be located "below the inferior cardiac nerve," and does not teach or suggest locations in the diaphragm area.

Applicants have amended independent claims 22 and 29 to recite a system comprising an implanted electrode that is coupled to the vagus nerve at a particular location, i.e., "at a location in a range from about two to about three inches above or below the patient's diaphragm." The claims as amended recite a structural element that is neither disclosed nor suggested by the cited reference. Newly added independent claim 34 recites an electrode that is "attached to a vagus nerve of the patient at a location below the patient's diaphragm." This structural element is likewise not disclosed or suggested by the cited reference.

Applicants submit that the claims as presently presented are allowable over the cited reference. Accordingly, it is respectfully requested that the proposed Amendment be entered, the claims reconsidered, and that early notice of allowability be provided.



03/27/06
Date

Respectfully submitted,

Timothy L. Scott
Timothy L. Scott
Reg. No. 37,931
Cyberonics, Inc.
100 Cyberonics Blvd.
Houston, Texas 77058

Phone: (281) 727-2652
Fax: (281) 853-2505

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231

on 03/27/06
(Date)

Dianne Mangrum
(Name of person making deposit)

Dianne Mangrum
(Signature)